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Richard Anthony Cudd

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EXAMINER

RUST, ERIC A

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/581,276	CUDD ET AL.	
	Examiner	Art Unit	
	ERIC A. RUST	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/01/2006, 07/24/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are pending in this application.

Priority

2. Acknowledgment is made of Applicants' claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy of Application No. 2003906918, filed on December 12, 2003 in the Australian Patent Office, has been received by the Office.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Scaling a Document to Facilitate Efficient Whole Page Printing."

Please note that Applicants are permitted to change the title to something other than suggested above, as long as the title is clearly indicative of the invention to which the claims are directed. See MPEP 606.01.

Specification

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code at, for example, pg. 2, line 8. Applicants are required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

5. Claims 6 and 9 are objected to because of the following informalities:

In regard to claim 6, the phraseology “said program comprising steps of: code for providing . . .,” recited in lines 3-12 is incorrect. Specifically, code cannot be steps. The Examiner recommends amending the claim by deleting the words “steps of” in the preamble of the claim.

In regard to claim 9, the two commas in line 3 of the claim appears to be a typographical error. The Examiner recommends deleting one of the commas.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 9, the recitation “wherein if the content on the last page is less than the predetermined amount, said method comprises the further step, before

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said scaling, of: determining a user preference for one of scaling the content to fit the nearest whole page or printing said plurality of pages,” recited in lines 3-6, is not clearly understood rendering the claim indefinite because it does not spell out explicitly the exact function of the claim limitation. For example, it is not clear how the determining step is done before the scaling if the content on the last page is less than the predetermined amount since in claim 8, from which claim 9 depends, the scaling is completed when the content is less than the predetermined amount.

For purposes of examination, the Examiner will interpret this recitation to simply mean that if the content on the last page is less than the predetermined amount, said method comprises the further step of: determining a user preference for one of scaling the content to fit the nearest whole page or printing said plurality of pages.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regard to claims 1-5 and 8-14, the claims are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court

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precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing.

While the instant claims recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, claim 1 is directed to a method for printing a document comprising the steps of: “providing a zoom property attribute to scale the document; displaying a preview window which shows the pages in the document the content of which is scaled based on the zoom property attribute; determining a user selection, within the preview window, for the pages of the scaled document; and printing a subset of the pages according to the user selection.”

The Applicants have not provided explicit and deliberate definitions of which particular apparatus is used for printing a document, i.e., executing the steps of “providing a zoom property attribute to scale the document; displaying a preview window which shows the pages in the document the content of which is scaled based on the zoom property attribute; determining a user selection, within the preview window, for the pages of the scaled document; and printing a subset of the pages according to the user selection,” or to limit the steps of “providing a zoom property attribute to scale

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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the document; displaying a preview window which shows the pages in the document the content of which is scaled based on the zoom property attribute; determining a user selection, within the preview window, for the pages of the scaled document; and printing a subset of the pages according to the user selection,” for transforming underlying subject matter (such as an article or material) to a different state or thing. Thus, the method of claim 1 would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine, i.e. a set of algorithm or a set of procedures without a machine for execution.

Independent claims 5 and 8 recite similar subject matter as claim 1, and claims 2-4 and 9-14 either directly or indirectly depend from claims 1 and 8, respectively, and are therefore rejected for the same reasons as set forth above.

In regard to claims 6-7, the claims define a computer readable medium embodying functional descriptive material (i.e., code). Moreover, the scope of the presently claimed invention encompasses products not falling within one of the four statutory categories of invention. For example, the computer readable medium of claims 6-7 are described as a signal incorporating a data structure within a carrier wave as disclosed in Applicants’ specification at, for example, pg. 8, line 21 – pg. 9, line 6.

“A transitory, propagating signal ... is not a “process, machine, manufacture, or composition of matter.” Those four categories define the explicit scope and reach of

subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” (In re Nuijten, 84 USPQ2d 1495 (Fed. Cir. 2007)).

Because the full scope of the claim as properly read in light of the disclosure appears to encompass non-statutory subject matter (i.e., because the specification defines/exemplifies a computer readable medium as a non-statutory signal, carrier waver, etc.) the claim as a whole is non-statutory.

In regard to claims 15-20, the claims define an application program embodying functional descriptive material (i.e., a computer program). However, the claims do not define a “computer-readable medium or computer-readable memory” and is thus non-statutory for that reason (When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to embody the program on “computer-readable medium” or equivalent; assuming the specification does NOT define the computer readable medium as a “signal”, “carrier wave”, or “transmission medium” which are deemed non-statutory (refer to “note” below). Any amendment to the claim should be commensurate with its corresponding disclosure.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (hereinafter, AAPA) in view of U.S. Patent No. 6,954,282 B2 to Miyamoto et al. (hereinafter, Miyamoto).

In regard to claim 1, AAPA discloses a method of printing a document, said document comprising a plurality of pages sourced from a computer network (**AAPA, pg. 2, lines 13-16**), said method comprising the steps of:

providing a zoom property attribute to scale the document (**AAPA, pg. 2, lines 13-16**);

displaying a preview window which shows the pages in the document the content of which is scaled based on the zoom property attribute (**AAPA, pg. 2, lines 13-16**);

AAPA does not specifically disclose determining a user selection, within the preview window, for the pages of the scaled document; and

printing a subset of the pages according to the user selection.

Miyamoto, however, discloses determining a user selection, within the preview window, for the pages of the scaled document (**Miyamoto, Fig. 6, item 13, and col. 4, lines 46-56**); and

printing a subset of the pages according to the user selection (**Miyamoto, Fig. 6, item 13, and col. 4, lines 46-56, a subset of the images are selected for printing**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Miyamoto with the teachings of AAPA for determining a user selection, within the preview window, for the pages of the scaled document, and printing a subset of the pages according to the user selection in order to easily print a subset of images, and to easily discriminate the subset of images that are to be printed from images that are not to be printed (**Miyamoto, col. 4, lines 56-59**).

In regard to claim 2, which depends from claim 1, Miyamoto discloses wherein the user preference is determined for each page (**Miyamoto, Fig. 6, item 13, and col. 4, lines 46-56**).

In regard to claim 3 which depends from claim 1, Miyamoto discloses wherein the user preference is determined by using a checkbox (**Miyamoto, Fig. 6, item 13, and col. 4, lines 46-56**).

In regard to claim 4, which depends from claim 3, Miyamoto discloses wherein the checkbox is in a vicinity of the previewed pages (**Miyamoto, Fig. 6, item 13, and col. 4, lines 46-56**).

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11. Claims 5-6, 8-10, 15-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of U.S. Patent No. 4,889,439 to Cook et al. (hereinafter, Cook), as evidenced by Canon Easy-WebPrint user Manual.

In regard to claim 5, AAPA discloses a method of printing a multi-page document sourced from a computer network (**AAPA, pg. 2, lines 13-16**), said method comprising the steps of:

providing a zoom property attribute to scale the multi-page document (**AAPA, pg. 2, lines 13-16**);

printing the scaled multi-page document (**AAPA, pg. 2, line 14, printing**)

AAPA does not disclose determining whether an amount of content on a last page of a scaled multi-page document, which is scaled based on the zoom property attribute, is less than a predetermined amount; and

when the amount of content is less than the predetermined amount, further scaling the scaled multi-page document down to fit to a nearest whole page and printing the further scaled multi-page document.

Cook, however, discloses determining whether an amount of content on a last page of a scaled multi-page document is less than a predetermined amount (**Cook, col. 1, lines 57-66, determining the line number of a paragraph that will spill over to the next page is essentially determining how much content is on a next page (i.e., will spill over to the next page)**). If there are only two pages being typed, then the

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next page would be the last page. The predetermined amount is the third to last line of the paragraph); and

when the amount of content is less than the predetermined amount, further scaling the scaled multi-page document down to fit to a nearest whole page (**Cook, col. 1, lines 57-66, if the line is the next to last line (i.e., less than the third to the last line), the document places the line on the current page to avoid widow lines on the next page, the Examiner reads placing the line on the current page past the border as scaling the document).**

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Cook with the teachings of AAPA for determining whether an amount of content on a last page of a scaled multi-page document, which is scaled based on the zoom property attribute, is less than a predetermined amount, and when the amount of content is less than the predetermined amount, further scaling the scaled multi-page document down to fit to a nearest whole page and printing the further scaled multi-page document in order to avoid orphan and widow lines, thereby increasing the aesthetics of a finished document (**Cook, col. 1, lines 44-46**).

In regard to claim 6, AAPA discloses a computer readable medium, having a program recorded thereon, where the program is configured to make a computer execute a procedure to print a multi-page document sourced from a computer network (**AAPA, pg. 2, lines 13-16, in order to perform the recitation cited on pg. 2, lines 13-16, AAPA (i.e., Netscape and/or Easy-WebPrint) would require a computer**

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readable medium, having a program recorded thereon, where the program is configured to make a computer execute a procedure to print a multi-page document sourced from a computer network), said program comprising the steps of:

code for providing a zoom property attribute to scale the document (**AAPA, pg. 2, lines 13-16, again, the code would be inherent**);

code for displaying a preview window which shows the pages in the document the content of which is scaled based on the zoom property attribute (**AAPA, pg. 2, lines 13-16, since the user is repeatedly reducing the page until the content fits onto the nearest whole page, a preview window would be inherent, again, the code is inherent**);

code for printing the scaled multi-page document (**AAPA, pg. 2, line 14, printing, again, the code is inherent**).

AAPA does not disclose code for determining whether an amount of content on a last page of a scaled multi-page document, which is scaled based on the zoom property attribute, is less than a predetermined amount; and

code for further scaling the scaled multi-page document down to fit to a nearest whole page when the amount of content is less than the predetermined amount.

Cook, however, discloses code for determining whether an amount of content on a last page of a scaled multi-page document is less than a predetermined amount (**Cook, col. 1, lines 57-66, determining the line number of a paragraph that will spill over to the next page is essentially determining how much content is on a next page (i.e., will spill over to the next page). If there are only two pages being**

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typed, then the next page would be the last page. The predetermined amount is the third to last line of the paragraph, see also, col. 2, line 37 for “code”); and

code for further scaling the multi-page document down to fit to a nearest whole page when the amount of content is less than the predetermined amount (**Cook, col. 1, lines 57-66, if the line is the next to last line (i.e., less than the third to the last line), the document places the line on the current page to avoid widow lines on the next page, the Examiner reads placing the line on the current page past the border as scaling the document, see also, col. 2, line 37 for “code”).**

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Cook with the teachings of AAPA for determining whether an amount of content on a last page of a scaled multi-page document, which is scaled based on the zoom property attribute, is less than a predetermined amount, and further scaling the scaled multi-page document down to fit to a nearest whole page when the amount of content is less than the predetermined amount in order to avoid orphan and widow lines, thereby increasing the aesthetics of a finished document (**Cook, col. 1, lines 44-46**).

In regard to claim 8, AAPA discloses a method of printing a document sourced from a computer network and spanning a plurality of printable pages (**AAPA, pg. 2, lines 13-16**), comprising the step of:

printing the content (**AAPA, pg. 2, line 14, printing**).

AAPA does not disclose determining whether an amount of content on a last page of said printable pages is less than a predetermined amount; and

when the determined amount of content is less than the predetermined amount, scaling the content down to fit the content to the nearest whole page.

Cook, however, discloses determining whether an amount of content on a last page of said printable pages is less than a predetermined amount (**Cook, col. 1, lines 57-66, determining the line number of a paragraph that will spill over to the next page is essentially determining how much content is on a next page (i.e., will spill over to the next page). If there are only two pages being typed, then the next page would be the last page. The predetermined amount is the third to last line of the paragraph**);

when the determined amount of content is less than the predetermined amount, scaling the content down to fit the content to the nearest whole page (**Cook, col. 1, lines 57-66, if the line is the next to last line (i.e., less than the third to the last line), the document places the line on the current page to avoid widow lines on the next page, the Examiner reads placing the line on the current page past the border as scaling the document**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Cook with the teachings of AAPA for determining whether an amount of content on a last page of said printable pages is less than a predetermined amount, and when the determined amount of content is less than the predetermined amount, scaling the content down to fit the content to the nearest whole

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page in order to avoid orphan and widow lines, thereby increasing the aesthetics of a finished document (**Cook, col. 1, lines 44-46**).

In regard to claim 15, AAPA discloses a printing application program arranged for printing a document sourced from a computer network and spanning a plurality of printable pages (**AAPA, pg. 2, lines 13-16, Netscape and/or Easy-WebPrint**), said program comprising:

code for printing the content (**AAPA, pg. 2, line 14, printing, the code is inherent**).

AAPA does not disclose code arranged to determine whether an amount of content on a last page of said printable pages is less than a predetermined amount;

code, operable when the amount of content is less than the predetermined amount, for scaling down the content to fit the content to the nearest whole page.

Cook, however, discloses code arranged to determine whether an amount of content on a last page of said printable pages is less than a predetermined amount (**Cook, col. 1, lines 57-66, determining the line number of a paragraph that will spill over to the next page is essentially determining how much content is on a next page (i.e., will spill over to the next page). If there are only two pages being typed, then the next page would be the last page. The predetermined amount is the third to last line of the paragraph, see also, col. 2, line 37 for “code”**);

code, operable when the amount of content is less than the predetermined amount, for scaling down the content to fit the content to the nearest whole page (**Cook,**

col. 1, lines 57-66, if the line is the next to last line (i.e., less than the third to the last line), the document places the line on the current page to avoid widow lines on the next page, the Examiner reads placing the line on the current page past the border as scaling the document, see also, col. 2, line 37 for “code”).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Cook with the teachings of AAPA for determining whether an amount of content on a last page of said printable pages is less than a predetermined amount; and when the amount of content is less than the predetermined amount, for scaling down the content to fit the content to the nearest whole page in order to avoid orphan and widow lines, thereby increasing the aesthetics of a finished document (**Cook, col. 1, lines 44-46**).

In regard to claims 9 and 16, which depend from claims 8 and 15, respectively, the claims are rejected in the same way as claims 8 and 15 above.

Moreover, the combination of AAPA and Cook disclose wherein the nearest whole page is the plurality less one, and if the determined amount of content is greater than said predetermined amount, then printing said plurality of pages (**AAPA, pg. 2, lines 13-16, and Cook, col. 1, lines 57-61**), and

wherein if the content on the last page is less than the predetermined amount, said method comprises the further step of: determining a user preference for one of scaling the content to fit the nearest whole page or printing said plurality of pages (**Cook, col. 1, lines 61-66, last line is printed**).

In regard to claim 10, which depends from claim 9, AAPA, (i.e., Canon Easy-WebPrint) and Cook disclose wherein said determining comprises presenting a dialog box to the user within a graphical user interface whereby the user can select one of scaling the content to fit the nearest whole page or printing said plurality of pages **(Canon Easy-WebPrint user Manual, labeled by Examiner as pg. 1, a GUI is shown, user can select print with out scaling document, or user can scale the document using the “Content Size” box disclosed in the GUI),**

said method being performed in conjunction with a graphical user interface arranged to display both a print preview of said document spanning said plurality of pages and a print preview of said document scaled to said nearest whole page **(Canon Easy-WebPrint user Manual, labeled by Examiner as pg. 1, a GUI is shown, the GUI is of a preview window that shows a preview of an image. The default image previewed is not scaled (see “Content Size” box which is at 100%). If Content size is adjusted, the preview image would be adjusted. Accordingly, the GUI displays both a print preview of said document spanning said plurality of pages and a print preview of said document scaled to said nearest whole page).**

In regard to claim 17, which depends from claim 16, AAPA (i.e., Canon Easy-WebPrint) and Cook disclose wherein said computer network comprises the World Wide Web and said printing application program is configured to interact with a web browser application program having an associated graphical user interface **(Canon Easy-**

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WebPrint user Manual, labeled by Examiner as pg. 1, a GUI is shown, the GUI is integrated into in Internet Explorer browser (see top left of GUI disclosed in Canon Easy-WebPrint user Manual, labeled by Examiner as pg. 1)),

said printing application program further comprising code arranged to display via said graphical user interface both a print preview of said document spanning said plurality of pages and a print preview of said document scaled to said nearest whole page (**Canon Easy-WebPrint user Manual, labeled by Examiner as pg. 1, a GUI is shown, the GUI is of a preview window that shows a preview of an image. The default image previewed is not scaled (see “Content Size” box which is at 100%). If Content size is adjusted, the preview image would be adjusted. Accordingly, the GUI displays both a print preview of said document spanning said plurality of pages and a print preview of said document scaled to said nearest whole page).**

In regard to claim 19, which depends from claim 17, AAPA (i.e., Canon Easy-WebPrint) discloses code for presenting a subsidiary graphical user interface box within said graphical user interface of said web browser application whereby a user thereof can select one of scaling the content to fit the nearest whole page or printing said plurality of pages (Canon Easy-WebPrint user Manual, labeled by Examiner as pg. 1, a GUI is shown, the subsidiary graphical user interface box is the toolbar shown in the GUI, the toolbar allows for scaling the content (“Content Size” box) and printing the pages (“Print” button)).

In regard to claim 20, which depends from claim 19, neither AAPA nor Cook discloses wherein said subsidiary graphical user interface comprises a dialog box including a user manipulable graphical representation of predetermined amount.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify AAPA so that said subsidiary graphical user interface comprises a dialog box including a user manipulable graphical representation of predetermined amount since it was known in the art that such modification provides a user a quick and easy way for a user to see the results of his/her adjustment.

12. Claims 7, 11-14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA and Cook, in view of Miyamoto.

In regard to claim 7, which depends from claim 6, neither AAPA or Cook discloses code for determining a user selection, within the preview window, for the pages of the scaled document; and

code for printing a subset of the pages according to the user selection.

Miyamoto, however, discloses code for determining a user selection, within the preview window, for the pages of the scaled document (**Miyamoto, Fig. 6, item 13, and col. 4, lines 46-56, the system described in Cook is a software application, so the code is inherent**); and

code for printing a subset of the pages according to the user selection
(**Miyamoto, Fig. 6, item 13, and col. 4, lines 46-56, a subset of the images are**

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selected for printing, the system described in Cook is a software application, so the code is inherent).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Miyamoto with the teachings of Cook and AAPA for determining a user selection, within the preview window, for the pages of the scaled document, and for printing a subset of the pages according to the user selection in order to easily print a subset of images, and to easily discriminate the subset of images that are to be printed from images that are not to be printed (**Miyamoto, col. 4, lines 56-59**).

In regard to claims 11 and 18, which depend from claims 10 and 17, respectively, the claims are rejected the same way as claim 10 above. Neither AAPA nor Cook disclose detecting a user selection of one of said print previews and printing the selected print preview.

Miyamoto, however, discloses the step of detecting a user selection of one of said print previews and printing the selected print preview (**Miyamoto, Fig. 6, item 13, and col. 4, lines 46-56, a subset of the images are selected for printing, when the user selects the print button, detecting a user selection of one of said print previews and printing the selected print preview would be required**).

In regard to claim 12, which depends from claim 8, neither AAPA, Cook, or Miyamoto disclose wherein said predetermined amount is user adjustable, said method further comprising the step of presenting a graphical user interface including a value of

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said predetermined amount and detecting a user's change to said amount made via said graphical user interface.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify AAPA wherein said predetermined amount is user adjustable, said method further comprising the step of presenting a graphical user interface including a value of said predetermined amount and detecting a user's change to said amount made via said graphical user interface since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284 (CCPA 1954).

In regard to claim 13, which depends from claim 12, the claim is rejected in the same way as claim 13 above. Moreover, the combination of AAPA, Cook, and Miyamoto discloses wherein said graphical user interface comprises at least one of a numerical representation of said value and a user manipulable graphical representation of said value (**Canon Easy-WebPrint user Manual, labeled by Examiner as pg. 1, a GUI is shown, and Cook, col. 1, lines 57-66, line number is numerical representation of said value**).

In regard to claim 14, which depends from claim 13, neither AAPA, Cook, or Miyamoto disclose representing said predetermined amount within a bounding area in a graphical user interface and detecting manipulation of said bounding area by the user, said manipulation thereby at least adjusting a scale factor for said scaling.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify AAPA to represent said predetermined amount within a bounding area in a graphical user interface and detecting manipulation of said bounding area by the user, said manipulation thereby at least adjusting a scale factor for said scaling since it was known in the art that such modification provides a user a quick and easy way for a user to see the results of his/her adjustment.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure and is as follows:

Sellers et al., U.S. No. 7,212,309 B1, teaches scaling pages of a document to reduce the number of pages in a document.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on (571)-272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

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/E. A. R./

Examiner, Art Unit 2625

09/10/2009

/Benny Q Tieu/

Supervisory Patent Examiner, Art Unit 2625